REMARKS

Claims 1 - 20 are pending in the present application. No new matter has been added. It is respectfully submitted that this Reply is fully responsive to the Office Action dated September 28, 2006. In light of the arguments presented below, Applicants earnestly solicit favorable reconsideration.

On the Merits

Claim Rejection - 35 U.S.C. § 102(e):

Claims 1-18 have been rejected under 35 U.S.C. § 102(e) as being anticipated by *Lee* (US Patent 6,658,576. Applicants respectfully traverse this rejection.

Independent Claim 1:

Independent claim 1 of the present invention requires:

A gateway card that is connected to an information processor and that receives and transmits data between different networks, the gateway card comprising:

[1]an access accepting unit that accepts an access request from an apparatus connected to the networks; and

[2]**an access control unit** that leads the **apparatus** to make access to an external apparatus in a state that the operation of the information processor is maintained in a power-saving operation mode,

[3]when the access request is accepted in a state that the operation of the information processor is in a power-saving operation mode and also when the access request corresponds to the access to the external apparatus.

The Examiner contends that the second part of claim 1, specifically the access control unit, is disclosed by *Lee* in figure 4, reference character 430. This appears to be a control circuit which switches relay 472R and monitors the activities of communication circuit 450.

The next part of the claim requires the **access control unit** to lead the **apparatus** to an external apparatus, while maintaining the processor state in a power saving mode. This feature does not appear to be disclosed or fairly suggested by *Lee*.

"The apparatus" as required in claim 1, is referring to a device such as a personal computer or home appliance for example, as discussed on page 1 of the present application. An example of an external apparatus could be a server on the world wide web. Thus, an "apparatus" such as a home appliance would be led by the access control unit to an external apparatus such as a server on the world wide web. This would allow communication between the **apparatus** and a server on the world wide web.

Instead of *Lee* disclosing a gateway card that connects an apparatus and external apparatus as required by claim 1, *Lee* appears to be aimed at allowing the downloading of information from a computer to a requesting device, through a network, while maintaining the computer in a conventional sleep state. See abstract.

Lee states that "energy conserving computer 300 comprise[s] basically an **energy conserving communication 400** [note figure 4] disposed on an energy conserving motherboard 320...." Column 11, lines 57-59 describing a second preferred embodiment. Thus communication board 400 of figure 4 is part of computer 300. The Examiner has stated that the gateway card as required in claim 1 is anticipated by communication board 400.

This embodiment described by *Lee* (second preferred embodiment) is described as an invention to "provide an **energy-conserving communication apparatus** remotely reachable for establishing instant communications...." Emphasis added. It appears that all the *Lee* invention is concerned with is establishing communications from one computer to another over a network and as mentioned above, maintaining the device in a conventional sleep state. *Lee* does not appear to disclose an "apparatus" as required in claim 1. The "apparatus," as required by claim 1, is connected to a network which is in turn connected to the gateway card.

Also, as indicated in the preamble of the claims, the gateway card transmits data between different networks; i.e. a local area network and a wide area network. *Lee* simply appears to disclose transmitting data across one network, evidenced from the passage quoted above and the abstract.

Therefore, because *Lee* only appears to disclose computer to computer communication, *Lee* cannot disclose connecting an "apparatus" from one network to a gateway card, which then leads the apparatus to connect to an external apparatus on another network.

Additionally, regarding the last element of claim 1, it requires that the information processor be maintained in a power saving operation when the access request is accepted in such a state, and the access request corresponds to an external apparatus. Thus, when the internal apparatus requests access to an external apparatus and the information processor is in a power saving state, the information processor will stay in that power saving state.

Lee does not disclose or fairly suggest this feature. As discussed above, as *Lee* does not disclose an "apparatus" as required in claim 1, *a fortiori Lee* can not disclose the function of those structures, namely, keeping the information processor in the power saving state when access is requested to an external apparatus.

Dependent Claim 2:

As claim 2 is dependent upon claim 1, the arguments presented above regarding claim 1 also apply to claim 2.

Independent Claim 3:

As independent claim 3 requires similar basic features such as an "access accepting unit," an "apparatus," and an "access control unit," the arguments described above relating to claim 1 also apply to claim 3. *Lee* does not disclose the structural components of claim 3, specifically "an apparatus" as also required in independent claim 1. As indicated above, *Lee* only appears to disclose communication from one computer to another computer over a network, not communication from an apparatus connected to a network which is connected to a gateway card, which in turn is connected to another network.

Additionally, claim 3 requires that an apparatus makes an access request to the information processor where the operation mode is returned from the power saving mode to the normal operation mode, when the access request corresponds to access the information processor, and shifts the operation mode from the normal mode to the power saving mode after the access ends.

As indicated above, because *Lee* does not contain the basic features of independent claim 3, *a fortiori Lee* can not disclose what is required by the claim through those features. Specifically, *Lee* does not the "apparatus" as required by claim 3 and therefore does not disclose a request which the apparatus makes.

Claims 4-18:

As claims 4-18 require similar structural features as those in claims 1-3, namely a gateway card connected to an information processor and at least two networks, the arguments presented above also apply to claims 4-18. The basic features of *Lee* do not anticipate what is required in the present claims.

Independent claims 4, 7, 10, 13 and 16, each require features similar to claim 1, requiring that the information processor be maintained in a power saving operation when the access request is accepted in such a state, and the access request corresponds to an external apparatus. Thus the argument recited above for claim 1 regarding this feature, also applies to claims 4, 7, 10, 13 and 16. Therefore, the rejection of these claims appears to be improper.

Additionally, as dependent claims 5, 8, 11, 14 and 17 depend from independent claims 4, 7, 10, 13 and 16 respectively, the argument presented above regarding those claims also applies to their dependent claims.

Independent claims 6, 9, 12, 15 and 18, each require features similar to claim 3, requiring that when an apparatus makes an access request to the information processor where the operation mode is returned from the power saving mode to the normal operation mode, when the access request corresponds to access the information processor, and shifts the operation mode from the

normal mode to the power saving mode after the access ends. Thus, the argument recited above for claim 3 regarding this feature, also applies to claims 6, 9, 12, 15 and 18.

Claim Rejections - 35 U.S.C. § 102(b):

Claims 19 and 20 have been rejected under 35 U.S.C. § 102(b) as being anticipated by *Dea* (US Patent 5,742,833).

Independent Claim 19:

Independent claim 19 requires in part:

> A gateway card that interconnects an information processor, at least one server via a first network, and at least one client via a second network ....

Thus, the gateway card must make three connections, one to the "information processor," one to the "server" via a first network and one to a "client" via a second network. An example of this embodiment can be seen with figure 1. Gateway card 510 is connected to a personal computer 520, a LAN 400 and a WAN 200.

The Examiner contends that the gateway card of claim 19 is disclosed by NIC (network interface controller) 112. The Examiner contends that NIC 112 interconnects and information processor 12 or 28, a server 26 or 18 via a first network and a client 31 via a second network. See figure 1.

However figure 2 shows NIC 112, and it appears to connect only to one network. *Dea* discloses that NIC 112 can be built into a motherboard of a station. *Dea* goes on to state "The function of such an NIC 112 generally is to provide the interface logic between the network and network connection 126 and the actual station 110, thereby facilitating the station being able to communicate with other devices **on the same network** such as a Token Ring, Ethernet, ATM, FDDI, etc." Emphasis added. Column 6, lines 2-11.

As is apparent from the quoted passage above, the NIC card appears to connect the network 126 with the actual station 110. In contrast the gateway card as required in claim 19 makes three connections, the information processor, the server and the client. See also figure 1 of the present application. Therefore, because *Dea* does not disclose the three connections of the gateway card required by claim 19, the rejection of claim 19 should be withdrawn.[1]

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[1] "[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999).

Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) (The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application "to gain an understanding of what the inventors actually invented and intended to encompass by the claim."); Thus, the preamble of the present claims should carry patentable weight.

Independent Claim 20:

As independent claim 20 contains the same features as discussed above regarding independent claim 19, the same arguments regarding claim 19 also apply to claim 20.

Claims 3, 5, 9, 12 and 18 have been rejected under 35 U.S.C. § 102(b) as being anticipated by *Gibson et al.* (US Patent 5,835,719).

Independent Claim 3:

Claim 3 requires in part:

> A gateway control method to be applied to a gateway card connected to an information processor and that receives and transmits data between different networks, the gateway control method comprising:
>
> An access request receiving step of receiving an access request from an apparatus connected to the networks;

As mentioned above, the gateway card connects at least three different components, an "information processor," and "different networks;" i.e. at least two networks. The Examiner contends that network controller 12 of *Gibson* discloses the gateway card required in claim 3. However, as indicated in figure 1, network controller 12 only appears to connect to one network, network 11. Thus *Gibson* does not disclose the underlying features of claim 3.

Independent Claim 12:

As independent claim 12 requires similar features to those discussed in independent claim 3, the same arguments provided for independent claim 3 also apply to independent claim 12.

Claim Rejection - 35 U.S.C. § 103(a):

Claims 19 and 20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lee*.

Independent Claim 19:

As indicated above regarding the analysis of the *Lee* reference with respect to claim 1, *Lee* does not disclose or fairly suggest a **gateway card** that transmits data between two networks. *Lee* only appears to disclose transmitting data from one computer to another via a network. This is not what is required by claim 19 as is apparent from the brief cited passage of the claim as shown earlier.

Independent Claim 20:

As claim 20 requires similar features to those discussed above, the arguments presented regarding claim 19 also apply to claim 20.

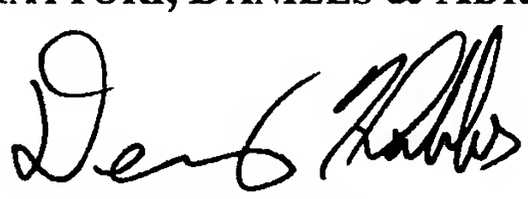
In view of the aforementioned remarks, Applicant submits that the claims are in condition for allowance. Applicant requests such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned agent to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP



Dennis M. Hubbs
Agent for Applicant
Registration No. 59,145
Telephone: (202) 822-1100
Facsimile: (202) 822-1111

TEB/DMH/tw